UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/083,278	05/22/1998	YOJI FUJIWARA	041-2013	3784

22429 7590 09/15/2003

LOWE HAUPTMAN GILMAN AND BERNER, LLP
1700 DIAGONAL ROAD
SUITE 300 /310
ALEXANDRIA, VA 22314

EXAMINER	
ZIMMERMAN, BRIAN A	
ART UNIT	**PAPER NUMBER**
2635	24

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/083,278	FUJIWARA ET AL.	
	Examiner	Art Unit	
	Brian A Zimmerman	2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3-6,8-17,19-21 and 23-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3-6,8-17,19-21,23-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

EXAMINER'S RESPONSE

Status of Application

In response to the applicant's amendment received on 7/15/03. The examiner has considered the new presentation of claims and applicant arguments in view of the disclosure and the present state of the prior art. And it is the examiner's position that claims 3-6,8-17,19-21,23-25 are unpatentable for the reasons set forth in this office action:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 3,4-6,8-10,14-17,19,22,24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically support could not be found for the audible sound or voice tones combined to make a song.

Claim Rejections - 35 USC § 103

2. Claims 11,12,14,15,20,23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the WO publication to Motorola (WO 96/06417, hereafter referred to as the Motorola Publication) in view of Wong (5394140).

The Motorola publication shows a pager, which receives codes. A first portion of a received code is compared to a stored address to detect if the message is directed to the particular paging receiver, page 4 lines 20+. A second portion of the codes is used to convey display information to the user (page 4 lines 34+), and a third portion of the codes is used to activate a sound generator to audibly generate recalled tones to be heard by the user for presenting an audible composition to the user (page 4 lines 35+). It is noted that an audio composition is a song.

It remains the examiner's position that the Motorola Publication does generate a series of tones where at least one tone has a frequency that is at least a portion of the chromatic scale. The chromatic scale is a series of notes or tones that can be used to generate or write an audible composition. It remains the examiner's position that the Motorola Publication would in fact generate at least one tone that would exist on the Chromatic Scale.

In the alternative, it is well known that the chromatic scale is a group of notes that can be used to create music or an audible composition much like the various forms of the English Language. Similarly, it is clear the a musical or audible composition for alerting would have been obvious in view of the Motorola Publication regardless of the exact notes or the exact manner in which to express or "write" those notes. Therefore, it would have been obvious to use musical

notes from different scales in the audible generated composition since such would have been common techniques to use different notes to generate a composition.

In an analogous art, Wong shows a pager, which generates audible messages in response to received message codes that are interpreted in view of stored corresponding codes. Wong shows displaying the call back number on the display, col. 3 lines 54-55. Wong also shows associating the call back number with an audio tone in a table format. See abstract and figure 2. This permits the user to have some creative control over how the audible composition is presented. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used an input means on the pager in order to permit the user to creatively control the audible output of an composition discussed in the Motorola document.

3. Claims 3-6,13,16,17,19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Motorola Publication and Wong as applied to claims 11,14, above, and further in view of Fisch (4873520).

In an analogous art, Fisch shows voice message pager. The pager of Fisch uses voice as an audible composition, in order to convey addition information to the user upon retrieval or playing of the message. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used voice as the audible composition in the above discusses system in order to convey additional information regarding the message.

4. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Motorola publication, Wong and Fisch as applied to claim 4 above, and further in view of Kawashima (5332994).

In an analogous art, Kawashima shows audible message pager. The pager of Kawashima uses the audible composition to convey addition information to the user. Kawashima uses a timer 12 to limit the time interval that the selected tone is generated; this provides protection to the power supply in that the audible generator does not drain the battery. It is also noted that stop commands are verily common in POCSAG systems. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a timer to limit the audible composition in the above discusses system in order to prevent excessive battery drain.

Response to Arguments

Applicant's arguments filed 7/15/03 have been fully considered but they are not persuasive.

The applicant states that the claimed invention displays picture data with simulated voice so that it appears that the pictured singer is singing the song. First, it is noted that the claimed invention does not specifically set forth that the pager displays a pictured singer. Secondly, even if it did such is not disclosed by

the instant specification. Therefore, this paragraph by the applicant should have no weight in the determination of the merits of this application.

The applicant argues that neither Wong nor the Motorola reference has voice tones of the chromatic scale. First, it is noted that claims 11,12,14,15,20,23-25 do not include voice tones, merely a broader "sound data" is present in these claims. Furthermore, the examiner has not cited Wong and the Motorola reference for the disclosure of voice tones; Fisch is cited for teaching voice tones. Furthermore, as discussed above he chromatic scale is a series of notes or tones that can be used to generate or write an audible composition. It remains the examiner's position that the Motorola Publication would in fact generate at least one tone that would exist on the Chromatic Scale. Additionally, this argument is directed to a measuring scale and is not so limiting as the applicant argues. If a reference discussed the operation of a system at a distance of 5 meters it would read on a claim that specified the English equalivent measurement. The applicant's argument is akin to arguing that even though the reference teaches operation at a distance, it does not teach the distance measured in meters. This does not overcome the fact that the reference (in this instance) does teach music or sound tones, which would exist in the scale the applicant argues.

The applicant argues that there is no disclosure in the reference(s) of activating a series of voice tones to reproduce a song. First it is noted that the

term song is broad. Songs cover a wide gamut of speech. Rap is considered a song, yet is merely more than a voice message or poem. It is the examiner's position that the voice message produced by Fisch is equivalent to a song. Fisch is the reference cited to teach the use of a series of voice tones to indicate information to the user that is specific to each message. When combined with the Motorola publication, which produces an audible composition, a song would be the result.

The applicant argues that Wong does not transmit data from the transmission side and then register the data to associate a specific sound pattern. The claims are not as narrow as the applicant argues. First it is noted that Claim 3 is the only claim to mention the registration of sound data and Wong teaches this limitation because it has a mode where the message data (call back number) is selected (entered during an add mode) and stored with a designated sound pattern.

The applicant argues that neither Wong nor the Motorola publication shows a relationship between a received code activated song that is associated with a pictorial display to coordinate the two into a new whole. The claims are not as limiting as the applicant argues; first the claims do not claims a pictorial display, most claim displaying "display data" while claim 25 includes displaying character data. Additionally, only claim 25 includes any form of coordinating of the display data and the sound data. Wong displays the received call back

number which is associated with the call back cadence, and therefore teaches a received code activated song associated with display characters as claimed.

The applicant argues that the Fisch ('520) reference does not uses a single voice message to indicate that a message is received, and does not provide a different voice message based upon the received signal. The applicant is incorrect, this is exactly what Fisch teaches. See steps 106-108.

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian A Zimmerman whose telephone number is 703-305-4796. The examiner can normally be reached on Off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Horabik can be reached on 703-305-4704. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Brian A Zimmerman
Primary Examiner
Art Unit 2635

BAZ